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09/764,688	01/16/2001	Mary Ann Fitzmaurice	40655.0100	6906

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EXAMINER

KIM, AHSHIK

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 09/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/764,688

Applicant(s)

FITZMAURICE ET AL.

Examiner

Ahshik Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 23-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 23-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Amendment*

1. Receipt is acknowledged of the amendment filed on April 16, 2003. In the amendment,  
5 claims 1, 6, 12, and 20 were amended. Currently, claims 1-20 and 23-29 remain for  
examination.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
10 obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in  
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are  
such that the subject matter as a whole would have been obvious at the time the invention was made to a person  
having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the  
15 manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the  
claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various  
claims was commonly owned at the time any inventions covered therein were made absent any  
20 evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out  
the inventor and invention dates of each claim that was not commonly owned at the time a later  
invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)  
and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 20, 23-27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over  
25 Masaki (JP 08-244,385) in view of Gunn (US 5,308,121).

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Re claims 20, 23-27, and 29, Masaki discloses a multiple-service card 1 associated with which there is a service partner (e.g., university if used as a student ID card, a business-firm if used as a personnel certificate, or a club/department if used as a membership card, etc.), a primary party (DNP) and a holder, the card 1 comprising a first side 1b and a second side 1a, the first side 1b having a first indicia associated with the primary party, the second side 1a having second indicia associated with the service partner, which is a provider of membership club services (English abstract and detailed description, paragraph [0008]), the second indicia including a service partner membership member, a magnetic strip 2a that contains account information in machine readable form, an image of the card holder (see figs. 1a & 1b; English translation: abstract and paragraph [0008] through paragraph [0011]).

Masaki fails to teach or fairly suggest that the primary party is a provider of credit services and the service partner is a provider of membership club services.

Gunn teaches the above limitation with the credit/service card companies (which serves as the primary party) offering a combination of services (which serves as the service partner) to be used with the credit card (e.g., automobile club membership, etc.) (see col. 2, lines 11-42), wherein the card having an expiration date 38 and a space for a signature 56 (see fig. 5).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Gunn into the teachings of Masaki in order to increase overall revenue via partnerships or business alliances wherein the credit card companies work with the service partners to provide user the more convenient way of saving money due to the complimentary given for using the card. In addition, combining the functions and benefits of many different cards into a single card may alleviate the need of carry multiple cards, thus

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attracting more people to use the credit/service card; and therefore, the credit card companies and service partners will be appreciated because they make more profit. Furthermore, such modification would provide Masaki with a more secure system wherein the signature of the card holder can be verified (i.e., by comparing the signature on the card and the signature on the receipt); and features such as expiration date would help preventing fraudulent use of the card. Accordingly, such modification would have been an obvious extension as taught by Masaki, and therefore an obvious expedient.

5        Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mackenthun (US 5,969,318) in view of Gunn and Masuda (US 5,569,897). The teachings of Gunn have been discussed above.

10        Re claims 1-19, Mackenthun discloses a method of providing a multiple-service card. The method comprises the steps of receiving an application for a multiple-service card from a consumer 10; communicating/transmitting the credit card information to a provider of credit services [40A-40I]; causing a multiple-service card to be sent to the consumer by the card manufacturing apparatus [22, 23]. Request a card administrator 30; the card administrator 30 communicating with a card service engine [40A-40I]; the card service engine [40A-40I] communicating with card generator [22, 23]; the card generator [22, 23] communicating with the card administrator 30; the administrator 30 communicating with the consumer 10 for confirmation (figs. 1-6; col. 4, line 30 through col. 10, line 54).

20        Mackenthun fails to teach or fairly suggest that a provider of credit services determine whether or not it desires to extend credit to the consumer.

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Gunn teaches the above limitation with the credit/service card companies (which serves as the provider of credit services or primary party) offer a combination of services (which serves as the service partner) to be used with the credit card (e.g., automobile club membership, etc.) (see col. 2, lines 11-42).

5           It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Gunn into the teachings of Mackenthun in order to provide Mackenthun with a more secure system, wherein the credit/service card company (which serves as the provider of credit services or primary party) is the one who offers other services to the card user; therefore, it is obvious that the credit card company/service or the  
10   primary party determine whether or not to extend credit or to offer the requested services to the user. Accordingly, such modification would have been an obvious extension as taught by Mackenthun, well within the ordinary skill in the art, and therefore an obvious expedient.

          Mackenthun as modified by Gunn fails to teach or fairly suggest the method of receiving at a service partner establishment an application and the service partner information related at  
15   least in part to membership in the service partner establishment.

          Masuda teaches the above limitation with an application, which is filled by the user/consumer, is received through the retail store/service partner (col. 1, lines 20-25).

          It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Masuda into the teachings of  
20   Mackenthun/Gunn in order to provide Mackenthun/Gunn with a more convenient system wherein the user can apply for a primary/secondary credit/membership/service card through a retail store/an establishment and knowing the approval result right away, he/she does not have to

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concern about forgetting to put the application in the mail or misplacing it and does not have to wait (with wonder) for the result, thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Mackenthun/Gunn, and therefore an obvious expedient.

- 5 6. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masaki as modified by Gunn as applied to claim 20 above, and further in view of Blank (US 6,089,611). The teachings of Masaki as modified by Gunn have been discussed above.

Re claim 28, Masaki/Gunn has been discussed above but fails to teach or fairly suggest a barcode representing a service partner membership number.

- 10 Blank teaches the above limitation with barcode 22 representing a service partner membership number (fig. 1b; col. S, lines 40+).

- It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Blank in order to provide Masaki/Gunn with a more organized and secure system wherein the system can keep track on the number of customers of each individual service partner. Furthermore, such modification would provide Masaki/Gunn with the capability of determining whether or not a valid member (i.e., by reading the membership number). Accordingly, such modification would have been an obvious extension as taught by Masaki/Gunn, and therefore an obvious expedient.

20 ***Response to Arguments***

7. The Applicants' amendment and arguments filed on April 16, 2003 have been carefully reviewed and considered, but they are not persuasive.

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It is the Examiner's opinion that the cited references (US 5,308,121 to Gunn, JP 08-244,385 to Masaki, US 5,569,897 to Mackenthun, US 5,569,897 to Masuda, and US 6,098,611 to Blank), alone or in combination disclose the claimed invention in the instant application.

The Applicants amended claim 1 such that claim 1 now reads "A method for providing a multiple-service card, the method comprising ..... if said provider of credit card services desires to extend credit to the consumer, causing a multiple-card to be sent to the consumer, wherein said multiple service card is configured for providing a primary party's services and a service partner's services wherein said step of determining comprises considering said credit card application information." In doing so, the Applicants argue that the amended claims overcome the teachings of the cited references.

In response to the Applicants' argument, the Examiner reviewed the Gunn patent. The card disclosed in the Gunn patent is a credit/service card (col. 2, lines 11+). Examiner notes that the Gunn patent provides detailed description on physical features of the card such as shape, size, and other components such as magnetic stripes and holograms etc. Although silent on business process of credit/service card, it is the Examiner's view that the Gunn patent teaches subject matter disclosed in claims 1 and 21. For example, The Shell Oil Company promotes Shell Master Card (<http://www.countonshell.com/ShellCreditCards.html>), which is an example of credit/automobile service card. A consumer may pick up an application at any Shell station, fills out and sends the form in. The MasterCard, a credit card company reviews the application form and either approves or disapproves application. Or, the reviewing and determining process may be accomplished by Shell or contracted to others by the MasterCard. When approved, the MasterCard (or the contracted partners) sends the physical card to a consumer, and the consumer



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may use it as a credit card or a gas card at Shell stations. The MasterCard is a credit card company (or a primary party), and Shell Oil Company is a one of many partners.

In response to the Applicants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or  
5 modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Multiples services cards are well known in the art, and are gaining rapid acceptance. In  
10 the instant case, the references to Gunn, Mackenthun and to Masaki are directed at multiple-service card and the related methods for the card. Accordingly, it would have been obvious to one ordinary skill in the art to incorporate Gunn's disclosure into Masaki references in order to increase revenue or add additional functionalities or participants.

The amended claims and remarks describing these elements have been given careful  
15 consideration, but in view of the above, the rejection made in previous Office Action is maintained. Accordingly, the Examiner has made this Office Action final.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time  
20 policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

5 however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Mollett et al. (US 6,505,772); Taylor (US 5,530,232); Zacharias (US 6,494,367) disclose multiple-service cards.

10 II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

15 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

20 Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].


25 *All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

30 

Ahshik Kim  
Patent Examiner  
Art Unit 2876

35 August 19, 2003

  
MICHAEL G. LEE  
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